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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,498	03/26/2004	Mitsuaki Oshima	28951.2011C12	7864
27890	7590	01/08/2009		
STEP TOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER				
WEST, THOMAS C				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
01/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,498

Applicant(s)

OSHIMA ET AL.

Examiner

THOMAS WEST

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29, 31-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29, 31-33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the Request for Continued Examination filed on October 8, 2008.
2. Claims 29, 31-33, 35-40 are currently pending and have been examined.

Response to Arguments

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "cipher key", "encoding means") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

4. Claims 29, 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 29, 32 recite accounting information and certain information, both of which lack antecedent basis in the specification.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29, 31-33, 35-40 are rejected under U.S.C. 103(a) as being unpatentable over O'Boyle et al., U.S. Patent No. 5,432,329 ("O'Boyle"), in view of Tanabe et al., US Patent No. 5,447,767 ("Tanabe") and in view of Arii, US. Patent No. 5,382,776.

Claims 29, 32, 33, 36-40:

O'Boyle, as shown, discloses a reading means, communicating means, reproducing means, and certifying certain information, accounting information (see at least column 1, lines 66-68 and column 2, lines 1-11, col. 9, lines 1-6).

encoding with the cipher key accounting information associated with a user account (col. 7, lines 5-19. col. 9, lines 24-35, col. 9, lines 54-62);

communicating certain information including the identification information and the accounting information to a server (col. 8, lines 67-69, col. 9, lines 1-6);

certifying a validity of the certain information through the server (col. 8, lines 67-69, col. 9, lines 1-6);

decoding the accounting information after certifying the validity of the certain information, reproducing the content data (col.9, lines 14-23, col. 8, lines 67-69, col. 9, lines 1-6);

the reproducing means reproduces the content data of the optical disk after checking the accounting information and certifying a possibility of the accounting to the user (col. 8, lines 67-69, col. 9, lines 1-6);

the accounting information includes a credit card number of the user (col. 8, lines 67-69, col. 9, lines 1-6).

checking the accounting information, certifying a possibility of the accounting to the user, wherein said reproducing of the content data of the optical disk comprises reproducing the content data of the optical disk after said checking of the accounting information and after said certifying of the possibility of the accounting to the user (col. 8, lines 67-69, col. 9, lines 1-6, col.9, lines 14-23);.

O'Boyle discloses an optical storage medium as shown above, but does not directly disclose an optical disc. It would have been obvious to perform a simple substitution of one type of optical storage medium for another, producing predictable results (KSR, 127 S.Ct. at 1740-41, 82 USPQ2d at 1396).

O'Boyle discloses the limitations as shown above. O'Boyle does not directly disclose unique to an optical disc and barcode, but Arii teaches: (see col. 6, lines 3-10)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Boyle to include the optical disc and barcode of Arii since O'Boyle explicitly teaches a security verification system capable of being based solely on optical media, eliminating the need for magnetic media (column 4, lines 25-28), and the barcode makes it difficult to manufacture illegal copies of a disk.

O'Boyle discloses the limitations as shown above. O'Boyle does not directly disclose stripe patterns along a radius, but Tanabe teaches (see at least column 44, lines 2-5, column 46, lines 40-43, and column 26, lines 57-69).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Boyle to include the stripe patterns along a radius of Tanabe since through level slicing, coded data can be decoded and since the concentric track on an optical disk follows along a radius as shown by the measuring of track signals along radiuses above (column 26, lines 57-69).

Claims 31, 35:

O'Boyle discloses the limitations as shown above. O'Boyle does not directly disclose a pre-pit region, but Tanabe teaches (see at least column 2, lines 27-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify O'Boyle/Tanabe to include the pre-pit region of Tanabe

since this an additional recording area for data such as disk identification and user information.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3621
January 4, 2009

Application/Control Number: 10/809,498
Art Unit: 3621

Page 7

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621